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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 490,884	01 24 2000	Lori Lisa Carrigan	1204	7780

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EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 08/26/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/490,884

Applicant(s)

CARRIGAN, LORI LISA

Examiner

Ashwin Mehta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 06/03/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,2,4,6-8,21,23 and 25-27 is/are allowed.
- 6) ☐ Claim(s) 3,5,9-20,22,24 and 28-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

**DETAILED ACTION**

***Request for Continued Examination***

1. The transmittal received on 03 June 2002 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/490,884 is acceptable and an RCE has been established. An action on the RCE follows.
2. The objection to claims 1, 21, 37, and 40 is withdrawn in light of the claim amendments.
3. The rejection of claims 4-6 and 23-25 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 02 January 2002 under item 3 is withdrawn upon further consideration.
4. The rejection of claims 1-51 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 02 January 2002 under item 4 is withdrawn in light of the claim amendments.
5. The rejection of claims 17, 36, and 43 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 02 January 2002 under item 5 is withdrawn upon further consideration.
6. The rejection to claim 50 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, is withdrawn and replaced with the indefinite rejection below.

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7. The rejection of claims 1-51 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, in the Office action mailed 02 January 2002 under item 6 is withdrawn in light of the claim amendments.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 14, 17, 33, 36, 41, 43, 45, and 46 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,188,001, for the reasons of record stated in the Office action mailed 02 January 2002 under item 2 for claims 1-17 and 21-46. Applicants traverse the rejection in the paper filed 03 June 2002. Applicant's arguments have been fully considered but were not found fully persuasive.

The instantly claimed inbred line and that of 6,188,001 share numerous traits, or differ due to minor morphological variations that would be expected to occur in different progeny of the same cultivar, and wherein said minor morphological variation would not confer a patentable

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distinction to PH51H. Further, the designation "PH51H" does not distinguish the instantly claimed seeds and plants from PH1W0, as this appears to be an arbitrarily assigned designation.

Applicants point out that the claims have been amended to include the ATCC deposit number (response, page 5, 5<sup>th</sup> full paragraph). However, claims 14, 17, 33, 36, 41, 43, 45 and 46 still read on the patented claims. The instantly claimed plants that are derived from crosses and breeding programs are not patentably distinct from the patented plants that are derived from crosses and breeding programs involving PH1W0, as they can express traits that are also expressed by the patented plants.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3, 5 (amended), 14, 22, 33, 40-46, 50 (amended) and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3 and 22, the recitation "wherein said plant has been manipulated to be male sterile" renders the claim indefinite. It is not clear if the claim is directed towards detasseled plants, or plants that have been transformed with a gene conferring male sterility. Claims 3, 22, 50, and 51 also appear to broaden the scope of their parent claims. The parent claims are drawn to plants with a defined set of characteristics, and claims 3, 22, 50, and 51 add more characteristics. The following amendments are suggested: 1) in claims 3 and 22, replace "manipulated to be male sterile" with --detasseled--; 2) cancel claims 50 and 51, and add a new

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claim 52 directed towards a method of producing a male sterile maize plant comprising transforming the maize plant of claim 2 with a nucleic acid that confers male sterility, and a new claim 53 directed towards a male-sterile maize plant produced by the method of claim 52.

In claims 5 and 24: there is improper antecedent basis for "protoplasts" in line 1. It is suggested that the term be removed from the claim, and that a new claim be introduced directed towards protoplasts produced from the tissue culture of claim 4 or 23.

In claim 40: the claim is indefinite because the recitation "comprising" in line 1 does not clearly indicate how many crosses are to be performed by the method. It is suggested that the recitation --F1 hybrid-- be inserted in claim 40, line 4 after "progeny", and in line 5 after "said".

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 9-20 and 28-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are broadly drawn towards any F1 hybrid seed produced by crossing PH51H with another, different maize plant; any F1 hybrid plant produced by growing said seed; maize plant PH51H transformed with any transgene(s); a method for producing a maize plant that contains one or more transgenes comprising crossing PH51H transformed with any transgene(s) with a non-transformed PH51H plant or a plant of another maize line, and maize plants produced

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from the method; any descendent of PH51H that expresses at least 2 traits listed in claim 14 that are also expressed by PH51H; any maize plant developed in a breeding program comprising PH51H or part thereof as the starting material; PH51H comprising one or more single gene conversions; an F1 hybrid seed, and plant grown therefrom, produced by crossing a plant having all the morphological and physiological characteristics as PH51H with a different maize line; or plants having all the morphological and physiological characteristics as PH51H and transformed with one or more transgenes, a method comprising crossing said plant with a non-transformed PH51H or plant of another maize line, and plants produced by the method; a maize plant that is any descendent of a maize plant having all the morphological and physiological characteristics as PH51H, and expressing any two of the listed traits that are also expressed by PH51H; any maize plant developed by a breeding program using any maize plant having all the morphological and physiological characteristics as PH51H; a process for producing inbred PH51H comprising planting a collection of hybrids having as one parent PH51H; method for producing PH51H-derived plants, and plants derived by the method.

The specification describes morphological and physiological traits of an inbred corn plant arbitrarily designated "PH51H" (page 15, line 30 to page 16, line 19; Table 1 on pages 17-19; page 35, line 1 to page 36, line 6; Tables 2A-2E and Tables 3A-3B on pages 38-44). The specification also indicates that hybrid plants were produced by crossing PH51H to a corn plant designated PH1W2. Numerous traits of the PH51H/PH1W2 hybrid were compared to other hybrid plants produced by crossing other inbred corn plants (page 36, line 29 to page 38, line 14; Tables 4A-4G, pages 51-57).

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However, the specification does not describe the plants produced by the corn breeding programs, transgenic PH51H plants, PH51H plants comprising single gene conversion(s), or by crosses wherein at least one ancestor is corn variety PH51H, other than PH51H/PH1W2. The morphological and physiological traits of the corn plants that are crossed with PH51H, and with progeny of that cross, are unknown, and the description of progeny and descendants of corn plant PH51H are unknown. The description of corn plant PH51H is not indicative of the description of plants and seed produced by the breeding programs and crosses, or of any of its descendants. The claimed invention also encompasses plants that express at least two of the "PH51H traits" listed in claims 14, 33, and 46. However, to say that a plant expresses two traits of another plant is not sufficient information to describe that plant, as numerous corn plants express at least two of the same traits as those expressed by PH51H. Two plant traits do not provide any description of the other traits of a plant. It is possible that the claimed plants inherited the genes governing those traits from an ancestor other than plant PH51H. For example, Piper (U. S. Patent No. 6,188,001) describes a corn plant, designated "PH1W0" which has at least two traits in common with PH51H, a relative maturity of approximately 96 based on the Comparative Relative Maturity Rating System for harvest moisture of grain, and adaptation to the Northcentral region of the United States, for example (col. 10, lines 50-62). The instantly claimed corn plants could have PH1W0 as an ancestor, as well as PH51H, in which the relative maturity and adaptation to the Northcentral region traits, for example, could have been inherited from PH1W0. The claims also encompass plants that do not have to express any of the traits that are expressed by PH51H. The specification does not describe any of the traits of such plants, and the morphological and physiological description of PH51H is not indicative of the description of such plants. The



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description of the PH51H/PH1W2 hybrid also does not provide any information concerning the description of any other hybrids. The morphological and physiological traits of PH51H/PH1W2 are not indicative of the traits expressed by other hybrids. The descriptions of PH51H and PH51H/PH1W2 are also not indicative of any transgenic plant or PH51H plants comprising single gene conversion(s). Transgenes may also be of any gene, including those that effect more than one trait. The morphological and physiological characteristics of any such plant are not described. For example, a transgene that is a transcription factor can effect more than just one gene, and multiple traits. Such plants would express different morphological and physiological traits from PH51H, which are not described. It is suggested that claims 11 and 30 be amended to list the types of transgenes contemplated in the specification, for example disease or pest resistance genes, provided the prior art teaches those isolated genes. Given the breadth of the claims encompassing corn plants expressing at least two traits that are also expressed by PH51H, or any trait, and descendents of PH51H, and lack of guidance of the specification as discussed above, the specification fails to provide an adequate written description of the multitude of corn plants and their parts encompassed by the claims.

11. Claims 18-20 and 47-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The claims are broadly drawn towards maize plant PH51H, or a maize plant having all the morphological and physiological characteristics of PH51H, further comprising one or more single gene conversions.

The specification teaches that single gene conversions, or introgression, of the disclosed maize plant through traditional breeding is contemplated (page 20, lines 16-31). However, the specification does not teach any PH51H plants comprising single gene conversions. It is not clear that single genes may be introgressed into the genetic background of a plant through traditional breeding. Hunsperger et al. (U.S. Patent No. 5,523, 520), Kraft et al. (Theor. Appl. Genet., 2000, Vol. 101, pages 323-326), and Eshed et al. (Genetics, 1996, Vol. 143, pages 1807-1817), for example, teach that it is unpredictable whether the gene or genes responsible for conferring a phenotype in one plant genotypic background may be introgressed into the genetic background of a different plant, to confer a desired phenotype in said different plant. Hunsperger et al. teach that the introgression of a gene in one genetic background in any plant of the same species, as performed by sexual hybridization, is unpredictable in producing a single gene conversion plant with a desired trait (column 3, lines 26-46). Kraft et al. teach that linkage disequilibrium effects and linkage drag prevent the making of plants comprising a single gene conversion, and that such effects are unpredictably genotype specific and loci-dependent in nature (page 323, column 1, lines 7-15). Kraft et al. teach that linkage disequilibrium is created in breeding materials when several lines become fixed for a given set of alleles at a number of different loci, and that very little is known about the plant breeding materials, and therefore it is an unpredictable effect in plant breeding (page 323, column 1, lines 7-15). Eshed et al. teach that in plants, epistatic genetic interactions from the various genetic components comprising

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contributions from different genomes may affect quantitative traits in a genetically complex and less than additive fashion (page 1815, column 1, line 1 to page 1816, column 1, line 1). In the absence of further guidance, undue experimentation would be required by one skilled in the art to overcome the difficulties and unpredictability of single gene conversions taught in the prior art.

***Claim Rejections - 35 USC § 102 & 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 14, 17, 33, 36, 41, 43, 45, and 46 remain rejected under 35 U.S.C. § 102 (e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 (a) as obvious over Piper (U.S. Patent No. 6,188,001). Applicants traverse the rejection in the paper received 03 June 2002.

Applicant's arguments have been fully considered but were not found fully persuasive.

The claims broadly encompass a plant, or parts thereof, having characteristics of maize inbred line PH51H, seed or progeny derived from maize plant PH51H, maize plants derived from PH51H, tissue culture derived from PH51H, methods of using said plant in a breeding program; methods to producing PH51H plants comprising one or more transgenes.

Piper teaches seed of maize inbred line PH1W0, plants produced by growing said seed, and plants and plant parts having all of the physiological and morphological characteristics of inbred line PH1W0. It appears that the claimed plants and seeds of the instant invention may be the same as PH1W0, given that each has a relative maturity of approximately 96 based on the Comparative Relative Maturity Rating System for harvest moisture of grain, and adaptation to the Northcentral region of the United States, for example (col. 10, lines 50-62). Alternatively, if the claimed plants, plant parts, and seeds of PH51H are not identical to PH1W0, then it appears that PH1W0 only differs from the claimed plants, plant parts, and seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur in different progeny of the same cultivar, and wherein said minor morphological variation would not confer a patentable distinction to PH51H. Piper also teaches methods for producing hybrid plants wherein a plant of inbred line PH1W0 is crossed with itself or another maize plant and crossed multiple times, and maize plant pedigree breeding (col. 2, line 66 to col. 5, line 18; col. 15, line 12 to col.. 16, line 25). The process of making the instantly claimed plants does not

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distinguish the plants themselves from those taught by the reference. Thus, the claimed invention was clearly *prima facie* obvious as a whole to one of ordinary skill in the art, if not anticipated by Piper

Applicant argues that plants developed utilizing the genetic makeup of PH51H transferred via crosses are within the scope of the invention, and that use of the genetics of PH51H and the plant with part of the genetics of PH51H is within the scope of the invention (response, page 8, last paragraph). However, the claimed plants may also have derived the traits from other plants in its ancestry, and these plants are also within the scope of the claims. Applicants argue that if one uses a plant other than PH51H to develop a very similar plant, then this is not within the scope of the invention (response, page 8, last paragraph). However, the claims do not indicate that the only plant used all of the crosses to derive the claimed plant is PH51H. The claims do not exclude plants that have non-PH51H plants in its ancestry. Applicant also argues that the plants must have 2 traits from PH51H, that these traits are controlled by many genes, and are evidence that PH51H has provided a genetic contribution to the progeny (response, page 8, last paragraph). However, it is not clear how the presence of the traits in the claimed plant is evidence that the genes controlling them were derived from PH51H, as the non-PH51H plants of the crosses also provided genetic contributions, which may also have included the genes controlling the listed traits.


13. Claims 1, 2, 4, 6-8, 21, 23, and 25-27 are allowed. Claims 3, 5, 9-20, 22, 24, 28-51 are rejected.

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***Contact Information***

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

August 22, 2002

  
ASHWIN D. MEHTA, PH.D  
PATENT EXAMINER